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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,073

03/31/2004

Paul F. Mastro

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06/14/2006

PATENT DOCUMENTATION CENTER

XEROX CORPORATION

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,073

Applicant(s)

MASTRO ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8 and 10-19 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-8, 10-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pub. No. 11-105039 (previously made of record; "JP '039"). Note the translation of this reference which has also previously been made of record.

JP '039 discloses an injection mold. The mold comprises a mold insert (13 or 15), which can be made of beryllium-copper (see abstract). The insert includes an electroless nickel layer (20) formed on the insert, and a chromium nitride layer (21) formed on the electroless nickel layer (see abstract). The insert is used in conjunction with a second insert, and first and second mold portions to form the injection mold (see Fig. 1).

JP '039 further discloses the electroless nickel layer should have a thickness of 5-10 microns or 500-2000 microns, and the surface layer of chromium nitride have a thickness of 3-5 microns (translation ¶¶ 18, 19 and 21).

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Claim 15 of the instant application recites that the "mold insert is insertable into a mold used to form a magnetic member from mold material." Written as such, this claim is merely reciting a use of the defined mold insert. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case, JP '039 discloses an apparatus with all of the structural features defined in claim 15 and there is nothing in the reference suggests the apparatus could not be used in a manner defined in claim 15. Thus, the apparatus of JP '039 anticipates the use limitations of the claim.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

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establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '039.

JP '039 discloses the mold insert as described above. In the embodiment described as anticipating the claims, the

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reference does not disclose the coated mold insert to be removable within a mold body. However, within another embodiment shown in Fig. 3 and described at paragraph 28 of the translation, the insert (23) is provided with screw holes (24) for attachment to the rest of the mold structure. As such, the reference suggests making inserts in a removable manner in combination with a mold structure. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's to have modified the insert shown in the embodiment shown in Figs. 1 and 2 of JP '039 as such to have made the insert to comprise screw holes because the reference further discloses the inventive inserts may be so connected to the mold structure and thus, removably connected to the mold.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '039 in view of Atake (U.S. Pat. No. 5,945,059; previously of record).

JP '039 discloses the apparatus as described above. JP '039 does not disclose support portions for the first and second mold portions. Support portions for mold portions, however, are well known in the art. Atake, for example, discloses an injection mold that is provided with first and second mold portions, as well as first and second support portions (11 and

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44) which act as platens to provide support and pressure to the mold during the molding operation (see for example, Fig. 1 and cl. 6, ll. 40-45). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the mold of JP '039 to further include mold support portions because such portions are known in the art to, among other things, apply pressure to the molding portions during the molding operation as suggested by Atake.

8. Applicant's arguments filed 31 March 2006 have been fully considered but they are not persuasive.

Applicant had amended claim 1 to recite that the claimed mold insert is removable, and argues that this distinguishes the claims from the prior art of JP '039.

Claim 1 of the instant application defines only the mold insert itself, as opposed to a mold in combination with an insert (as is the case with claim 17). Therefore, to recite that the claimed insert is "removable" within the context of claim 1 relates only to the potential use of the claimed mold. While JP '073 is silent as to the inserts (13 and 15) being removable after installation within the disclosed mold, nothing in the reference indicates the inserts themselves could not be used in a removable manner in a different molding apparatus. As

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such, claim 1 defining a removable insert is anticipated by JP '039. Further, it appears that the reference suggests the making of removable inserts with a molding apparatus as described above in conjunction with claim 17.

9. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached at (571) 272-1316. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

 6-12-6
Donald Heckenberg
Primary Examiner
A.U. 1722